

RECEIVED
CENTRAL FAX CENTER

SEP 26 2005

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/764,068	
	Filing Date	1/19/2001	
	First Named Inventor	Jeff Eder	
	Art Unit	3628	
	Examiner Name	Clement Graham	
Total Number of Pages in This Submission	16	Attorney Docket Number	AR - 19

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Asset Trust, Inc.		
Signature	/B.J. Bennett/		
Printed name	B.J. Bennett		
Date	09/26/2005	Reg. No.	

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature	/B.J. Bennett/		
Typed or printed name	/B.J. Bennett/	Date	09/26/2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

In short, the second reason the cited combination would be expected to fail is because completion of the required processing requires a substantial advance relative to the state of the art that has been defined by the Examiners of cross referenced applications and the cited combination of references fails to teach the required advances while documenting additional instances of novelty, newness and/or non-obviousness in the claimed invention.

Summarizing the above discussion, the orthogonal teachings of the cited references and a substantial body of evidence developed by the Examiners of cross-referenced applications (and the current application) provides convincing proof that the cited combination is an almost certain failure not a probable success. The Assignee notes that there are still other ways in which the absence of a reasonable expectation of success for the cited combination can be documented.

The 1 July 2005 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more limitations for every claim.

Far from establishing a prima facie case of obviousness for claims 36 - 70, the cited combination of references in the 1 July 2005 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of references when the cited references teaches away from their proposed combination, by advocating a combination of references that is an almost certain failure and by relying on a combination of references that fails to suggest almost all of the claim limitations.

Another way the combination of references cited in the 1 July 2005 Office Action fails to establish a prima facie case of obviousness for claims 36 - 70 is that it fails to make the invention as a whole obvious as required by MPEP § 2141.02 which states that:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.

As noted previously, the obviousness rejections are based on a combination of Marshall and Tull Jr.. Marshall and Tull Jr. both teach away from the method of the instant

application in a number of ways. As noted previously, the two references also teach away from their own combination. Taken together the cited combination of references fails to make the invention as a whole obvious. The cited combination also fails to make a single aspect of the claimed invention obvious. These failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious.

The fourth way the 1 July 2005 office action fails to establish a prima facie case of obviousness is that it does not teach how a system for portfolio management and a virtual reality system could be combined to produce anything useful. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the office action has not described how the teachings of these references would be combined or the reason for doing so. The references documenting the state of the art for cross referenced applications teach away from the proposed combination. Furthermore, as detailed above, the reference teachings make it obvious that there are a number of reasons that the cited combination should not be made and that once made it could not reasonably be expected to produce anything useful.

The Assignee notes again that there are still other ways in which all §103 obviousness rejections in the 1 July 2005 Office Action for claims 36 – 70 can be traversed.

Request for reference(s)

On December 2002 and September 2004 notices of allowability provided by the Examiner of the instant application were withdrawn from cross-referenced application 10/097,344. The Assignee presumes that, in keeping with established procedures, the withdrawal of these notices of allowability were supported by one or more references. Accordingly, the Assignee hereby requests that any reference or references used to support a withdrawal of a notice of allowance for 10/097,344 be added to the official (written) record for the instant application so that they may be addressed in a subsequent office action and/or appeal.

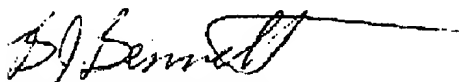
Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,



B.J. Bennett, President Asset Trust, Inc.
Date: September 26, 2005